

REMARKS

Applicants express appreciation to the Examiner for consideration of the subject patent application. This communication is in response to the Office Action mailed October 7, 2009, in which the following actions were taken:

(1) claims 1, 3-4, 10-14, 16-17, 19-20, 22, and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0168554 of Tsao (hereinafter “Tsao”) in view of Japan Patent Application 2001-049155 of Iijima (hereinafter “Iijima”) and U.S. Patent No. 6,585,366 to Nagata et al. (hereinafter “Nagata”);

(2) claims 5-6, 15, 21, and 28 were rejected as being unpatentable under 35 U.S.C. § 103(a) over Tsao in view of Iijima and Nagata and further in view of Japan Patent Application 2002-207275 of Wang et al. (hereinafter “O’Connor” to preserve continuity with previous communications);

(3) claim 29 was rejected as being unpatentable under 35 U.S.C. § 103(a) over Tsao in view of Iijima and Nagata and further in view of U.S. Patent Publication No. 2003/0198885 of Tamagawa et al. (hereinafter “Tamagawa”);

(4) claim 30 was rejected as being unpatentable under 35 U.S.C. § 103(a) over Tsao in view of Iijima and Nagata and further in view of Japan Patent No. 02026747 (hereinafter “Deguchi”); and

(5) claims 31-41 were rejected as being unpatentable under 35 U.S.C. § 103(a) over Tsao in view of Iijima, O’Connor and Nagata.

Reconsideration of the application is respectfully requested in view of the following responsive remarks.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected each of pending claims 1, 3-6, 10-17, 19-22, and 26-41 under 35 U.S.C. § 103(a) as being unpatentable over Tsao in combination with one or more secondary references as listed above.

Under 35 U.S.C. § 103(c), subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f), and (g) of § 102 shall not preclude patentability under § 103(a) when said subject matter was subject to common ownership at the time the claimed invention was made. 35 U.S.C. § 103(c)(1). The claims at issue were filed on March 16, 2004. Tsao is a publication of a patent application filed on February 4, 2004 and published on August 4, 2005. As Tsao is an application and was published after the filing date of the present claims, it is not prior art under subsections (a) or (b) of § 102. Rather, it only qualifies as prior art under § 102 (e), by virtue of its filing and subsequent publication date. However, Tsao sets forth subject matter developed by a person other than Appellants, but which was subject to assignment to the same entity (i.e. Hewlett Packard) as of March 16, 2004. Therefore, Tsao cannot support a rejection under § 103(a).

As all rejections cite Tsao as the primary reference, and as 35 U.S.C. § 103(c)(1) is applicable to Tsao, any rejection under 35 U.S.C. § 103(a) using Tsao is improper. Thus, Applicants respectfully submit that none of the rejections present a *prima facie* case of obviousness under 103(a) against pending claims 1, 3-6, 10-17, 19-22, and 26-41. As a result, the Applicants request that all pending rejections be withdrawn and the claims pass to issuance.

CONCLUSION

In light of the above, Applicants respectfully submit that pending claims 1, 3-6, 10-17, 19-22, and 26-41 are in condition for allowance. Therefore, Applicants request that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after consideration of this response, the Examiner is strongly encouraged to call Gary Oakeson at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this response to Deposit Account No. 08-2025.

DATED this 1st day of December, 2009.

Respectfully submitted,

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